

2006

PATENT ATTORNEYS

EXAMINATION

PAPER A2

**The New Zealand Law and Practice
relating to Patents and Designs**

Regulation 158 (1) (a)

Duration: 3 hours (plus 10 minutes for reading)

Question 1 (10 marks)

Comment on the patentability in New Zealand of the following inventions. To what might the claims be directed?

- a) A new surgical device intended for use in performing a new method of keyhole surgery on humans and other mammals. (2 marks)
- b) A new computer program for controlling a known ultra-sonic scanner: the new program enables the scanner to produce better resolution images of the body. (2 marks)
- c) A new pharmaceutically active compound is particularly suitable for treating ringworm in humans and other mammals. (2 marks)
- d) A known pharmaceutical compound used for treating athlete's foot now discovered to be useful in treating ringworm in humans and other mammals. (2 marks)
- e) A known pharmaceutical compound used for treating ringworm in humans and other mammals: the compound has been applied topically (to the skin) in the past but it has now been discovered that it is much more effective when taken orally. (2 marks)

Question 2 (10 marks)

- a) Your ingenious but financially embarrassed client, Getafix, has made an invention of a magic potion. Getafix has persuaded a wealthy quarry owner, Obelix, to finance a patent application in New Zealand for the invention. However, Obelix has only agreed to pay for the patent application if he is named as a co-applicant. There is the future possibility of filing convention patent applications overseas but Obelix has not yet made any commitment to finance those.

Explain to Getafix how Obelix can be made a co-applicant and also explain the consequences of making Obelix a co-applicant. (4 marks)

- b) A patent application naming Getafix and Obelix as applicants is filed with a complete specification. Soon after filing the application Getafix and Obelix have a serious

argument because Getafix will not give Obelix any magic potion. Getafix wants to ensure there is no publication or commercialisation of the invention at this stage. Obelix refuses to have anything more to do with the patent application. Getafix immediately persuades a well-off friend, Asterix, to continue financing the patent application. Asterix agrees but requires that he be named as a co-applicant instead of Obelix. Obelix will not co-operate.

Advise Getafix of the options available for him to have the patent application name himself and Asterix as the only applicants. (4 marks)

c) Obelix is removed as a co-applicant and the application proceeds in the names of Getafix and Asterix.

Must a declaration as to inventorship be filed? Whether yes or no; give a reason. (2 marks)

Question 3 (10 marks)

You receive instructions to have a PCT international application enter the national phase in New Zealand. The instructing letter from your US associate firm gives the following information.

International application:	PCT/US2004/012345
International filing date:	11 February 2005
International publication date:	7 September 2005
Priority application:	US Patent Application 10/222,737
Priority date:	13 February 2004
International applicant:	Alphabet Soups, Inc.
Inventor:	Alf A Bet

a) On checking the specification before filing the national phase entry, you see that page 1 of the specification includes the following paragraph:

Cross reference to related application

This patent application is a continuation-in-part of US utility patent application serial number 09/333,747 filed in the US Patent and Trademark Office on 27 July 2003 by Alf A Bet, the entire contents of which are incorporated by reference herein.

What issue(s) arise from this paragraph? What advice do you give to your associate?

What questions do you ask your associate? (5 marks)

b) You recall having filed an earlier application for Alphabet Soups, Inc. You check your records and confirm that. The earlier application claims convention priority from US patent application 09/333,747. What might you do to satisfy yourself that the claim to convention priority is valid? (1 mark)

c) Your associate's letter is accompanied by a copy of the assignment from the inventor to the applicant as recorded in the US Patent and Trademark Office. The assignment is dated 14 February 2005.

What additional issue(s) arise? How might any additional issue(s) be addressed? (4 marks)

Question 4 (8 marks)

a) Section 38 of the Patents Act 1953 gives the Commissioner discretion to allow amendment of a complete specification after acceptance of the patent application. Section 38 is subject to section 40 of the Act. Section 40(1) sets out provisions governing whether any amendment can or cannot be allowed. What are those provisions? (2 marks)

b) Would the following amendments be allowable before acceptance? Would they be allowable after acceptance? Give reasons.

i) Broadening of claim 1 to match the already broader statement of invention contained in the specification. (2 marks)

ii) Correction of translation errors in the verified English translation of a French language PCT application that has entered the national phase in New Zealand. (2 marks)

iii) Insertion of an example missing from the complete specification, which example is present in the provisional specification. (2 marks)

Question 5 (6 marks)

a) How does the issuing of a notice of acceptance affect the patent application that is accepted? What are the consequences of the advertisement of acceptance of the application in the official journal? (3 marks)

b) Your client has seventeen New Zealand patents in her own name. She wants to assign these to a company she has set up with other shareholders to manufacture the patented inventions. She instructs you to prepare an assignment but, to minimise costs, she does not want to register the assignment at the Intellectual Property Office at the present time if she does not have to. She asks if it is mandatory to register the assignment and, either way, if there are any adverse consequences if she does not. Advise her. (3 marks)

Question 6 (4 marks)

In September 2005, an Assistant Commissioner of Patents issued two decisions on oppositions by Vialactia Biosciences (NZ) Limited against patent applications 509193 and 509194 in the name of Agriculture Victoria Services Pty Ltd. One issue in these oppositions was whether a document on a computer server outside New Zealand, but accessible from New Zealand by way of the Internet, was “published” (as defined in section 2 of the Patents Act 1953) in New Zealand. The Assistant Commissioner held that the document was published in New Zealand from the date it can be shown to be accessible on the server.

You have filed a design application in New Zealand for a vase. In an examination report, the examiner raises an objection, referring to the above-mentioned decisions and citing a UK registered design for essentially the same design of vase. The examiner says the UK

design was registered before the date of your application and the representations of the UK registered design are available from the UK Patent Office website.

What arguments could you try making against the examiner's objection? (4 marks)

Question 7 (12 marks)

Write about the following topics. Identify any significant issues associated with each.

- a) Date of registration of a design. Cover both non-convention and convention design applications. (3 marks)
- b) Design of addition under section 8 of the Designs Act 1953. (3 marks)
- c) Sets of articles. (3 marks)
- d) Ownership and right to apply for registration of a design. Cover both non-convention and convention design applications. (3 marks)

Question 8 (10 marks)

Your client, BOTLS Ltd, has devised a new range of bottles to be used for selling fruit juices. The range comprises bottles of distinctly different shapes. Each differently shaped bottle is intended for a different fruit juice. However, all the differently shaped bottles have the same distinctively shaped neck.

Your client asks about the following scenarios. Advise your client how each scenario might be achieved. Indicate the nature of any statements of novelty that might be filed.

- a) Your client wants maximum registered design protection for its range of bottles. (4 marks)
- b) Your client wants registered design protection for its range of bottles, but at minimum cost. (2 marks)

c) Your client is unsure whether to go for maximum registered design protection or for registered design protection at minimum cost. Your client would like a year to test the market before making a final decision. (4 marks)

Question 9 (12 marks)

a) Referring to the Designs Act 1953, give the definition of “article”. (1 mark)

b) Your client, RACRS KK, is an overseas manufacturer of motorcycles. Following receipt of instructions from your client, you file two design applications.

(i) One application is for a wing mirror that can be used on a variety of motorcycles whether made by your client or by other manufacturers. The wing mirror consists of a distinctively styled mirror unit (comprising a mirror fitted in a mirror housing) attached at one end of an elongated stem. The other end of the stem is adapted to be releasably clamped to the handlebar of a motorcycle. The statement of novelty claims novelty in the shape and/or configuration of the mirror unit.

You receive an examination report raising an objection that the design is not registrable because it is not a design applied to an “article” as defined in section 2 of the Designs Act 1953. The examiner’s reasoning is that novelty is claimed for only the mirror unit of the wing mirror and the mirror unit does not qualify as an article because it is not sold separately from the stem.

Advise your client how the objection can be addressed. (5 marks)

(ii) The other application is for a stylish fuel tank for a motorcycle that is suitable for only one model of motorcycle made by your client.

You receive an examination report raising an objection that the design is not registrable because it is not a design applied to an “article” as defined in section 2 of the Designs Act 1953. The examiner’s reasoning is that the fuel tank is a type of “spare part” that does not qualify as an article.

The examiner explains:

In *Ford Motor Co Ltd's Design Applications* [1995] RPC 167, the House of Lords stated that in many cases an answer as to whether a spare part qualifies as an article will be supplied by applying the criterion that in order to qualify, "a spare part has to have an independent life as an article of commerce and not be merely an adjunct of some larger article of which it forms part".

A "fuel tank for a motorcycle" does not have an independent life as an article of commerce and is merely an adjunct of the motorcycle of which it forms part. Such a part is essential to the shape of the complete motorcycle and would not have been designed with the intention that it could be made and sold separately from the complete motorcycle.

Advise your client how the objection can be addressed. (6 marks)

Question 10 (8 marks)

Are the following designs validly registrable by means of one or more applications under the Designs Act 1953? Assume the designs are novel. Give reasons for your answers. Where you consider that a design is registrable, give a suitable statement of novelty.

- a) Children's birthday cakes made in the form of the numbers 0 to 9, each cake being in the form of one of the numbers. (2 marks)
- b) Worker's overalls of known shape having light-reflective bands arranged to look like an "X" on the front and the back of the chest region of the overalls. The sole purpose of the reflective bands is as a safety feature. (2 marks)
- c) A mobile telephone having within its housing a novel array of flanges to receive the electronic components and battery of the telephone. The flanges can only be seen when the screws holding the front and back parts of the housing together are removed and the housing is opened. (2 marks)

- d) The tread of a tyre. (2 marks)

Question 11 (10 marks)

Your client, R Tist, has designed a paperweight comprising a hand-worked clay base on which polished pebbles have been stuck by hand in a particular eye-catching pattern. Your client intends developing a machine to automate the production of the paperweight at some later date.

You have obtained registration of the design and your client is manufacturing and selling the hand-made paperweight, while working on the machine to automate the process.

However, not all is well. A craft shop owner, K O Pier, who bought one of your client's paperweights began making and selling a paperweight virtually the same as that made by your client. K O Pier also started by making his paperweight by hand but has just begun manufacture of his paperweight by machine.

Your client was incensed by this scurrilous activity and wrote a letter to K O Pier threatening to sue for infringement of the registered design if K O Pier did not stop making the paperweight. K O Pier replied that he has stopped but is seeking legal advice. The thought of K O Pier seeking legal advice has made R Tist nervous and she has returned to you for advice.

Advise R Tist about the following matters, giving reasons for your advice.

- a) Are any of the activities of K O Pier an infringement of the registered design? (2 marks)
- b) What consequences could arise from R Tist's letter? (2 marks)
- c) In the circumstances given, would it have helped in any way for R Tist to have marked her paperweights to give notice of the registered design? (2 marks)

d) Why is marking of products to give notice of design registration usually desirable?
(2 marks)

e) Has R Tist any other possible remedy? (2 marks)